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08/882,197	06/25/97	GREER	42390.P4072

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EXAMINER

MEINECKE DIAZ, S

ART UNIT PAPER NUMBER

2765

DATE MAILED: 09/28/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

# Office Action Summary

Application No.  
08/882,197

Applicant(s)  
Greer et al.

Examiner  
Susanna Meinecke-Díaz

Group Art Unit  
2765



☒ Responsive to communication(s) filed on Aug 15, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-14 and 16-45 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-14 and 16-45 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2765

## **DETAILED ACTION**

### ***Response to Amendment***

1. This office action is responsive to the Applicant's amendment filed August 15, 2000.

Claim 15 is cancelled.

Claims 39-45 have been added.

Claims 1-14 and 16-45 are currently pending.

2. The previous objection to the specification has been withdrawn.

The previous claim objections have been withdrawn.

The previous 112, second paragraph rejections are withdrawn.

*The following objections and rejections reflect the Examiner's updated analysis of the claims in light of the extensive claim amendments made:*

### ***Specification***

3. The Examiner has re-read the specification in hopes of gaining a better understanding of the claims; however, she is still confused by the disclosure. For example, it is not clear whether or not the rule page or the rule book or the agent is synonymous with a cookie. The Examiner's best guess as to what the invention truly is involves an interpretation of the rule page as a cookie and

Art Unit: 2765

the rule book as a collection of cookies stored on one's computer. Then, somehow a user's profile (i.e., agent) is created based on the overall collection of cookies. This profile helps advertisers determine which advertisements to target the user with. If this indeed is the invention, it is not clear why the Applicant is using more obscure words such as "rule page" and "rule book" when these are not the typical terms used in the art.

In lines 1-4 of page 11, the Applicant states that the "triggering program determines if data is important." Does this merely refer to a filtering of data to pull out only the most relevant records (in this case, advertisements)?

On page 11 (starting at line 9), the Applicant talks about updating the rule page by reassessing user data. However, sometimes the Applicant says that the rule page creates the most applicable rules, yet the Applicant also states that the rule page stores a set of rules. It is not clear how a rule page can create its own rules. And, if the rule page does not create its own rules, how are the rules updated to reflect the user's changing profile?

#### *Claim Objections*

4. Claim 43 is objected to because of the following informality:

Claim 43, line 1, delete "secong", insert --second--

Appropriate correction is required.

Art Unit: 2765

*Claim Rejections - 35 USC § 101*

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 14, 16-20, 23, 27, 32, 40, 42, and 45 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

While claims 14, 16-20, 23, 27, 32, 40, 42, and 45 are limited to the technological arts (e.g., they are limited to a computer environment), claims 14, 16-20, 23, 27, 32, 40, 42, and 45 are deemed non-statutory for failing to recite a practical application within the technological arts. It is not clear from the claim language what practical purpose(s) claims 14, 16-20, 23, 27, 32, 40, 42, and 45 set out to achieve.

The Examiner does recall her interview with the Applicant's representative; however, she does not recall telling the Applicant's representative that claim 14 is statutory. As a matter of fact, the Examiner recorded in her notes that claims 14 and 15 were still non-statutory while claims 1 and 7 would be deemed statutory since they actually carry out a transmission of data. Claim 14 still recites a future transmission of data (i.e., it is not clear whether or not the transmission is actually carried out). Also, please note that claim 22 (which is dependent from claim 14) has been deemed statutory since it positively recites the transmission of data.

Appropriate correction is required.

Art Unit: 2765

*Claim Rejections - 35 USC § 112*

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-14 and 16-45 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In claims 1-14 and 16-45, it is not clear how one of ordinary skill in the art could make, without undue experimentation, the claimed invention such that the rule book itself generates a rule based on the user rule page. A specific interpretation of the phrase in question will be addressed in the art rejection below.

Appropriate correction is required.

9. Claims 1-14 and 16-45 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claims 1-14 and 16-45, the originally specification provides no support for “the rule controlling a direction of the content from a database.” It does provide support for the following statement. “The control and direction of the information by the rule book 136 is based on user profiles 140, 142 and 144” (page 6, lines 23-35 of the specification); however, this statement does not explain how the rules themselves control the

Art Unit: 2765

direction of the content. A specific interpretation of the phrase in question will be addressed in the art rejection below.

Appropriate correction is required.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1-14 and 16-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what it meant by “the rule controlling a direction of the content from a database to be transmitted.” For example, how is the content direction controlled? What is meant by “content direction?” Does this phrase literally refer to where the content is copied elsewhere in the system?

Furthermore, claims 39 and 40 contain the trademark/trade name MICROSOFT® ACTIVE X™. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of

Art Unit: 2765

goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name.

Appropriate correction is required.

### *Response to Arguments*

12. Applicant's arguments filed August 15, 2000 have been fully considered but they are not persuasive.

The Applicant argues the following:

“Davis discloses a tracking program embedded in a file which is downloaded from a server and runs on a client to monitor various indicia (Davis, Col. 4, lines 46-47). In contrast, the present invention discloses a rule book that generates rules based on a user rule page. The rule controlling the selecting of a content from a database.

“Fitzpatrick discloses a media association agent to monitor, build, maintain and recall links based on prior actions and user choices (Fitzpatrick, Col. 2, lines 27-29). Fitzpatrick does not disclose a rule book that generates rule controlling the selecting of a content from a database.

“The Examiner interprets the rule book in the present invention as a database that generates various rules corresponding to different conditions. Applicants disagree. The rule book in the present is more than a database. Not only that the rule book can generate rules based on the information obtain from the target computer in a rule page but it also can transmit a content from a database to the target computer under the control of a rule.” (Page 13 of Applicant's amendment)

First of all, the Examiner used a combination of Davis in view of Fitzpatrick, along with Official Notice to reject claims 1-14, 16-21, 27-30, and 36-38. The Official Notice statements



Art Unit: 2765

were relied upon to help fill in some of the blanks regarding the use of rules. The Applicant has ignored the Official Notice statements. In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Furthermore, the Applicant has not sufficiently addressed the 35 U.S.C. 112, first paragraph rejection regarding the generation of rules by a rule book (which is similar to one of the previously pending 35 U.S.C. 112, first paragraph rejections from the previous office action). Applicant's argument is moot.

Additionally, the claims recite "the rule controlling a direction of the content from a database" (as opposed to "the rule controlling the selecting of a content from a database"). Applicant is arguing limitations not found in the claim language. Applicant's argument is moot.

*With each amendment, the claims become more unintelligible. The Examiner cannot reasonably apply art until the claims clearly express what the Applicant's invention is and until all 35 U.S.C. 112, first and second paragraph rejections are adequately addressed. As a result, the Examiner has chosen to maintain the existing art rejection as a whole to apply to all of the claims treated on the basis of their merits. The Examiner also makes a brief*

Art Unit: 2765

*comment regarding the obviousness of the newly incorporated limitations found in claims 44 and 45.*

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-14, 16-21, 27-30, and 36-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al. (U.S. Patent No. 5,796,952) in view of Fitzpatrick et al. (U.S. Patent No. 5,423,043), as discussed in sections 7 and 8 of paper no. 12.

As per claims 1, 7, and 14, the added limitation “the rule book generating a user specific rule, the user specific rule automatically being varied according to additional user information” has been interpreted as a database which generates various rules corresponding to different conditions. For example, if it determined that a particular user is a man, the content provider then transmits the data to him if he is between the ages of 35 and 40, while, if the user is a woman, the content provider transmits the data if she is between the ages of 30 and 38. In other words, various “IF...THEN” conditions (i.e., rules) are stored in the database (i.e., rulebook). Official notice is taken that maintaining such of database of various “IF...THEN” rules for different situations is old and well-known in the art. It would have been obvious to one of

Art Unit: 2765

ordinary skill in the art at the time of Applicant's invention to implement Davis' rulebook with "IF...THEN" rules for different situations in order to allow for greater precision when targeting content at different users.

As per claims 1 and 7, the added limitation "a triggering agent to determine if further user information is needed to allow the content provider to verify an identification code and a baseline profile for the user" has been interpreted as meaning that enough data is gathered by the triggering agent so as to be able to access a uniquely corresponding identification code and a baseline profile for the user. In other words, if there are 10 users with the last name "Smith", a first name would then be needed. Suppose the actual user is "Nicole Smith", but there are two users named "Nicole Smith" in the system, then the system narrows the profile down to two. A third piece of uniquely identifying data is needed, such as an address or a social security number. Such a feature is necessary for Davis' system to be operative; otherwise, a single user's profile could not always be accessed and there would be no way of targeting content to each specific user.

The limitations of claims 39-43 have already been addressed or are inherent to the rejection of claims 1-14, 16-21, 27-30, and 36-38. Regarding claims 44 and 45, official notice is taken that it is old and well-known in the art to target particular ad banners at users based on each user's demographics. This is a common practice when trying to promote an effective advertising campaign. For example, children's television shows are often padded with commercials directed at children, while adult television shows are usually accompanied by advertisements which

Art Unit: 2765

appeal more to adults. The same technique is commonly used on the Internet as well. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to target users with ad banners deemed the most appealing to each user based on his/her profile in order to create as effective of an advertising campaign as possible.

Claims 22-26 and 31-35 are so unclear that they have not been treated on the basis of their merits (i.e., no art has yet been applied).

### ***Conclusion***

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 2765

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna Meinecke-Díaz whose telephone number is (703) 305-1337. The examiner can normally be reached Monday-Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tod Swann, can be reached at (703) 308-7791.

The fax number for Formal or Official faxes to Technology Center 2700 is (703) 308-9051 or 9052. Draft or Informal faxes for this Art Unit can be submitted to (703) 305-0040.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

SMD

September 25, 2000



ERIC W. STAMBER  
PRIMARY EXAMINER